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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
BKA.0009US

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on **September 6, 2006**

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Typed or printed name **Nancy Meshkoff**

Application Number	Filed
09/764,748	January 18, 2001

First Named Inventor: Jonathan E. Lowthert

Art Unit	Examiner
2623	Kieu Oanh T. Bui

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number **50,457**
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

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September 6, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jonathan E. Lowthert et al.	§	Group Art Unit:	2623
		§		
Serial No.:	09/764,748	§	Examiner:	Kieu Oanh T. Bui
		§		
Filed:	January 18, 2001	§	Atty. Dkt. No.:	BKA.0009US
		§		
For:	Providing Content Interruptions	§	Confirmation No.:	7988
		§		
		§	Customer No.:	21906

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE AND ACCOMPANYING ARGUMENT

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, please consider this submission as a request for a pre-appeal brief conference with accompanying arguments.

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Date of Deposit: September 6, 2006
I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Nancy Meshkoff

ARGUMENTS

To establish *prima facie* obviousness, the prior art references must teach or suggest all of the limitations of the claims. As Srinivasan and Arsenault do not teach or suggest all of the limitations of claim 51, *prima facie* obviousness has not been established.

Claim 51 recites a personal-use receiver to receive content and an advertisement, and a cache, coupled to the receiver, to store the content, the advertisement, and instructions. The examiner cites to Srinivasan as disclosing a cache (117) coupled to a receiver (119), to store content, an advertisement, and instructions. *See* Paper No. 20060601, page 3. Srinivasan does not clearly disclose that content is stored in the cache 117.

Referring to Figure 12 of Srinivasan, a video broadcast stream 127 comes in through a subsection of the signal-receiving module (119) at the lower left-hand corner of the figure. From the subsection, the signal goes through pipeline 129 via buffer 133. There is no indication in Figure 12 that stream 127 is stored in the cache 117. Since the stream 127 is not clearly stored in the cache 117 then the rest of the rejection fails.

That is, claim 51 also recites instructions that enable the receiver to detect, during play of a particular content item that is being accessed from the cache, an interruption in the access of the particular content item, the interruption based on a user's unique pattern of usage of the particular content item. If Srinivasan does not store content in the cache 117, then a particular content item is not accessed from the cache for play and Srinivasan does not detect an interruption in the access of the content item from the cache whether the interruption is due to a user's action or not.

Even if Srinivasan did store a particular content item in the cache 117, which he does not, *prima facie* obviousness still is not established. Simply, Srinivasan does not disclose an interface, in the receiver, to insert an advertisement for display in response to detecting the change in the access to the particular content item, where the interruption in the access of a particular content item (from the cache) is based on a user's unique pattern of usage of the particular content item, as is indicated in claim 51.

As was explained above, in Srinivasan, a video broadcast stream 127 flows through the pipeline 129 via buffer 133. *See* Figure 12. Another stream, such as an annotated stream 125 may also flow through the pipeline 129, but in a different buffer, buffer 131. *Id.* The streams

flow through the buffer for "purposes of synchronization." Column 21, lines 27-29. The time allowed for buffering is "reasonable" such as a few seconds. *Id.* at lines 29-33.

The two streams 125 and 127 are buffered for synchronization because one stream may arrive before the other and therefore be out of sync with the other stream. Column 21, lines 34-41, column 30, lines 40-62. As Srinivasan has determined that only a few seconds are needed for buffering, any differences in times of arrival are offset by those few seconds. And for these same reasons, buffers 131 and 133 of the pipeline 129 continuously synchronize streams 127 and 125. Column 21, lines 60-65. Generally, after flowing through the pipeline 129, streams 125 and 127 are combined and are sent as one stream to a video RAM of a display module. Thereafter, a single stream is output for display. Column 21, line 63-column 22, line 3. Thus, the primary purpose of Srinivasan's system 115 is to synchronize streams, such as video advertisements with a main video stream, so they can be combined in an appropriate manner. *See* column 29, lines 48-54, column 30, line 63-column 31, line 29.

All other control is implemented by an ad server (221). Column 34, lines 24-44. Namely, the ad server accesses ads and controls the integration of ads with the primary video stream. Column 34, lines 37-42. For example, there are *predetermined* advertising slots in a video broadcast of which the ad server is aware, and the ad server selects which ads should be delivered for insertion in those slots. Column 31, lines 5-57; column 32, lines 12-21. The ad server controls all video feed and ads to orchestrate delivery of the video data stream and the ads such that the system 115 can synchronize the two streams (within a few seconds) to insert the ads in tagged, predetermined time-slots in the main video. Column 30, lines 63-66; column 31, lines 10-15. Clearly, Srinivasan's system 115 (Box 229, Figure 12) has nothing to do with storing content and advertisements for selection and display. The only thing Srinivasan's receiving unit does is synchronize streams, *all other control is by the ad server.*

The examiner asserts that it would have been obvious to one of ordinary skill in the art to modify Srinivasan's system with Arsenault's teachings to access a cache, the access of a particular content item based on the user's unique pattern of usage of a particular content item, and playback the content item any time. Paper No. 20060601, page 4. This assertion is respectfully traversed. First, as can be deduced from the explanation of Srinivasan, the set top box does not detect an interruption in the access of a particular content item (from the cache) where the interruption is based on a user's unique pattern of usage of the content item, and the

set top box does not have an interface, in the receiver, that inserts an advertisement for display in response to detecting a change in the access to the particular content item. As is explained above, Srinivasan's ad insertion is controlled by an ad server and ads can *only* be inserted in predetermined time slots. Thus, the proposed modification on its face is deficient as it does not address inserting an advertisement *in response to* detecting a change in the access of a particular content item (from the cache).

Furthermore, the cited art does not teach the desirability of such a modification. Mere identification of parts of a claimed invention does not render the claim obvious—there must be some suggestion or motivation in the art of the desirability of such a combination. *In re Kotzab,* 217 F.3d 1365, 1370, 55 U.S.P.Q. 2d 1313 (Fed. Cir. 2000). Additionally, the proposed modification cannot change the principle of operation of the prior art invention being modified. MPEP § 2143.01(VI). As is explained above, the principle of operation in Srinivasan is control by an external entity such as an ad server and mere synchronization of two live feeds by a set-top box. Other than at the ad server, there is no mechanism in Srinivasan's for ad selection and orchestration of advertisements with content. For these reasons alone, the examiner's rejection is in error.

Furthermore, even if there were a suggestion to modify Srinivasan, which there is not, the modification of Srinivasan in accordance with Arsenault's teachings still would not teach every limitation of claim 51 as Arsenault does not disclose the insertion of an advertisement in response to detecting the change in access to a particular content item where the change in access is due to an interruption based on a user's unique pattern of usage of the particular content item.

Like Srinivasan, Arsenault's placement of advertising is predetermined. Referring to Figure 8, Arsenault shows four playback options for a content item. The option that is played back depends upon the user's selection of a service option, such as a director's cut or an edited version that excludes mature content. Column 17, line 53-column 18, line 36. Because the broadcaster sends "a collection of edited versions," the edited portions are predetermined. The only thing that is not known is which edited version the user will select. Thus, once the selection is made, the CPU organizes and retrieves data packets according to the selection. There is no disclosure in Arsenault that the CPU looks for an interruption in the access of a particular content item from a cache that is based on a user's action, and *if* an interruption is detected, *then* insert an advertisement for display; otherwise, if an interruption is not detected, continue retrieval of the

content. Mere assembly of data packets is not the same. Therefore, neither Srinivasan nor Arsenault in combination teach or suggest all of the limitations of claim 51.

As a final point, Srinivasan does not disclose a personal-use receiver that collects information to enable a credit to a content provider for the display of an advertisement. As was explained, all control in Srinivasan is by the ad server, including any charges to advertisers. Column 34, lines 1-23.

For each of these reasons the examiner has not established *prima facie* obviousness for claim 51. Under a similar analysis, *prima facie* obviousness has not been established for independent claims 31 and 41. As none of the independent claims is obvious, none of the dependent claims is obvious either.

For each of these reasons, the examiner has not established *prima facie* obviousness and the application should be allowed to pass to issue.

Respectfully submitted,

Date: September 6, 2006

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